



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,899	09/18/2003	Brian T. Worsham	25343/37:7	7026

32642 7590 05/11/2009  
STOEL RIVES LLP - SLC  
201 SOUTH MAIN STREET, SUITE 1100  
ONE UTAH CENTER  
SALT LAKE CITY, UT 84111

EXAMINER
----------

NGUYEN, THUY-VI THI

ART UNIT	PAPER NUMBER
----------	--------------

3689

MAIL DATE	DELIVERY MODE
-----------	---------------

05/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/665,899

Applicant(s)

WORSHAM ET AL.

Examiner

THUY VI NGUYEN

Art Unit

3689

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-35, 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This is in response to the applicant's communication filed on 02/13/2009.0, wherein:

Claims 19-35, 37 are currently pending;

Claims 19-20, 23, 25-26, 29, 32 and 37 have been amended;

Claims 1-18 and 36 have been cancelled;

#### ***Claims Status***

2. As of 10/07/08, independent method claim 19 is amended as followed:

19. A computer-implemented method of returning customized information from a computer-readable storage medium ~~database~~ in response to requests about a specific tangible object having attributes, the method comprising:

a) receiving at a computer a first request from a first venue for information on the specific tangible object in inventory;

b) reading a representation of the tangible object from the computer-readable storage medium ~~database~~, the representation including attributes of the specific tangible object;

c) ~~applying a first rule associated with the first venue to the representation of the tangible object to generating~~ a first view of the specific tangible object, wherein the first view is generated by applying a first rule associated with the first venue to the representation of the specific tangible object such that the first view includes only attributes in compliance with the first rule;

- d) returning the first view to the first venue;
- e) receiving at the computer a second request from a second venue for information on the specific tangible object
- f) ~~applying a second rule associated with the second venue to the representation of the tangible object to~~ generating a second view of the specific tangible object, wherein the second view is generated by applying a second rule associated with the second venue to the representation of the tangible object such that the second view includes only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute in the second view is not in the first view; and
- g) returning the second view to the second venue

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3689

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-24 (method), 25-31 (method), and 32-35 and 37 (method) are rejected under 35 U.S.C. 102(e) as anticipated by SKORSKI (US 2004/0012631) or, in the alternative, under 35 U.S.C. 103(a) as obvious over BAMFORD (US 7,496,543).

As for independent **claim 19**, SKORSKI discloses a computer-implemented method of returning customized information from a computer-readable storage medium in response to requests about a specific tangible object having attributes, the method comprising:

a) receiving at a computer a first request from a first venue for information on the specific tangible object in inventory;

{see figure 1-3, at least pars.0013, 0019,0026-0029 This is inherently included in SKORSKI, e.g. consumer *selects a link requesting* the online catalog for purchasing a product/object , the consumer *generates an input request* for a particular product, and information about the product will be retrieved, e.g. a user request may be is a retailer or a patent}

b) reading a representation of the tangible object from the computer-readable storage medium, the representation including attributes of the specific tangible object;

{see at least pars. 0019-0024 wherein SKORSKI discloses the database storage computer system including databases, which store product information/object

Art Unit: 3689

information e.g. veterinary products, orthopedic products, and *product group identification and code* which are considered as an attribute of the product/object}

c) generating a first view (display) of the specific tangible object, wherein the first view is generated by applying a first rule associated with the first venue (site) to the representation of the specific tangible object such that the first view includes only attributes in compliance with the first rule;

{see figures 1-2, at least pars. 0009-0010 "*display data according ... selected criteria, ...type of user that accesses the information*", pars. 0013, 0024-0029, this inherently included in SKORSKI for generating a first view of the object applying a first rule, and the first view includes only attributes in compliance with the first rule. e.g. SKORSKI discloses the steps of *filtering* of a product database to derive an online catalog for a retailer, e.g. *select product by product group identification* and then by *specific products*. Each subset of product group identification generates different price/attributes for the same specific product as shown on figure 2. For an example if the patient accesses the online medical store to view product information, the information is filter and only shows the price of specific product as patient level group identification. The price information of other group (e.g. retailer physicians practice group) will be filtered}

d) returning the first view to the first venue (site);

{see at least pars. 0009-0010 "*display data according ... selected criteria, ...type of user that accesses the information*", pars. 0016, 0023 disclose the display data according selected criteria e.g. selecting the different product group identification}

e) receiving at the computer a second request from a second venue (site) for information on the specific tangible object;

{see figure 1-3, at least pars.0013, 0019,0026-0029 This is inherently included in SKORSKI, e.g. consumer *selects a link requesting* the online catalog for purchasing a product/object , the consumer *generates an input request* for a particular product, and information about the product will be retrieved, e.g. a user request may be is a retailer or a patent}

f) generating a second view (display) of the specific tangible object, wherein the second view is generated by applying a second rule associated with the second venue (site) to the representation of the tangible object such that the second view includes only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute in the second view is not in the first view;

{see figures 1-2, [0009 "*display data according ... selected criteria, ...type of user that accesses the information*", at least pars. 0013, 0024-0029, this inherently included in SKORSKI for generating a second view of the object applying a second rule, and the second view includes only attributes in compliance with the second rule. e.g. SKORSKI discloses the steps of *filtering* of a product database to derive an online catalog for a retailer, e.g. *select product by product group identification* and then by *specific products*. Each subset of product group identification generates different price/attributes for the same specific product as shown on figure 2. For an example if the retailer physician's practice accesses the online medical store to view product information, the information is filter and shows the discount price of specific product; The viewing price for the same

product is different for different group (patient group and retailer group). This is considered as the attribute/price in the first view is different than the attribute/price in the second view for the specific tangible object or product.}.

g) returning the second view to the second venue (site).

{see at least pars. 0009-0010, 0016, 0023 disclose the display data according selected criteria e.g. selecting the different product group identification}

Note that the general concept of generating a view (or display or web page) of the object based on a rule associated with the first venue (a site) is inherently included in the teachings of SKORSKI as shown on pars. [0009, 0016-0021], and Fig. 3.

Alternatively, the teaching of BAMFORD ET AL cited the well known customize information for a product using the pricing rule/engine, e.g. customize the price based on the several factors such as manufacture preferences, distributor preference, identify of a buyer, order volume, the location of buyer. The various manufacturer preferences, distributor preference, or buyer can access the e-market place through the internet, input a request for quote, and then receive a display (view or web page) containing information about a price schedule based on the above factors {see BAMFORD, abstract, see at least figures 1-5, at least col. 3, lines 45-67, col. 4, lines 1-67, col. 5, lines 1-14; col. 5 lines 65-67, col. 6, lines 1-8}. Therefore, it would have been obvious in one of ordinary skill in the art to modify the teaching of SKORSKI to explicitly include the teaching of selectively displaying requested view (display) as a function of rule associated with the venue (website) as taught by BAMFORD for displaying different customized prices based on the various entities such as on the several factors such as



Art Unit: 3689

manufacture preferences, distributor preference, identify of a buyer, order volume, the location of buyer.

Note: This appears to be a "data processing" method, therefore, the limitation after "data" or "information" or "attribute" or "view" or "specific tangible object" etc, have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for dep. claim 20, which discloses the receiving attribute to the specific product or object and storing the attribute in the computer readable storage medium, this inherently included in SKORSKI, see figure 1-3, at least pars. 0019-0020, 0028-0029.

As for dep. claim 21, which describes the specific function of the object or data stored in the database, i.e. an automobile, this is non-functional descriptive material (NFDM) and has no patentable weight. Furthermore, this is inherently taught in SKORSKI as shown in the catalog product database; par. 0003-0005.

As for dep. claim 22, which discloses the venues a re websites accessible by users at remote locations, this is taught in SKORSKI figures 1-3, pars. 0018-0019, 0021, 0023.

As for dep. claim 23, SKORSKI discloses different group identification information view different price/attribute for a specific product/object as indicated above. This is inherently included the generating the third view of the specific object by applying the third rule. Moreover, the duplicate of services or steps for multiple effects are well known and would have been obvious to a skilled artisan. See *In re Harza*, 124 USPQ 378, CCPA 1960.

As for dep. claim 24, which discloses the first view includes the first value and excludes the second value, and the second view include the second value excluded the first value, this is inherently taught in SKORSKI see figure 2, pars. 0028-0029.

As for independent method claim **25**, which is the combination of independent method claim 19 and 20, it's rejected for the same reason set forth in the rejection of claims 19 and 20 above. Further more, the first limitation which recites "storing a first attribute having first and second values in a database" is non-functional descriptive material which carries no patentable weight.

As for dep. claims 26-30, which basically have the same limitation as in dep. claims 20-24 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-24 above.

As for independent method **claim 32**, which is the combination of independent method claims 19 and further limitations of receiving requests about objects and applying a multiple of rules (second rule or third rule or fourth rule) for each venue. The duplicate of features (tangible objects) or steps (using two rules for each venue) for

multiple effects is well known and would have been obvious to a skilled artisan if duplicate effects are desired. See *In re Harza*, 124 USPQ 378, CCPA 1960.

As for dep. claims **33-35**, which deal with basically have the same limitation as in dep. claims 20-22 above, they are rejected for the same reason set forth in the rejection of dependent claims 20-22 above.

As for dep. claim **37**, which deals with applying a multiple of rules (second rule or third rule or fourth rule) for each venue, the duplicate of step or feature (rule) for multiple effects is well known and would have been obvious to a skilled artisan if duplicate rule effects is desired. See *In re Harza*, See *In re Harza*, 124 USPQ 378.

### ***Response to Arguments***

6. Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3689

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3689

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ThuyVi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
4/7/09